



06-01-07

Express Mail No. EB 132603464 US

EFM/6258

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent No.: 7,214,683

Issued: May 8, 2007

Application of: Aberg *et al.*

Confirmation No.: 9369

Application No.: 09/039,260

Group Art Unit: 1625

Filed: March 16, 1998

Examiner: Chang, C.

For: COMPOSITIONS OF
DESCARBOETHOXYLORATADINE

Attorney Docket No.: 4821-306
(JD 208423-999305)

Petition Under 37 C.F.R. § 1.182

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

06/04/2007 BABRAHA1 00000004 503013 7214683
01 FC:1462 400.00 D1

Sir:

It is respectfully requested that the terminal disclaimer submitted during prosecution of U.S. Application No. 09/039,260, which mentioned only Sepracor as assignee, be replaced with the terminal disclaimer submitted herewith. The basis for grant of this petition and provision for the required petition fee are provided below. Separate provision for the terminal disclaimer fee is also provided herein.

This petition is being concurrently submitted with a Petition Under 37 C.F.R. § 3.81(b) and a Request for Certificate of Correction to clarify that the above-identified patent is assigned to both Sepracor Inc. ("Sepracor") and University of Massachusetts.

Basis for Grant of Petition

It has recently been brought to the attention of the Patentees that an incorrect statement was inadvertently made in connection with a terminal disclaimer submitted March 17, 2006 in connection with U.S. Application No. 09/039,260. That terminal disclaimer states that Sepracor "is the assignee of the entire right, title, and interest in and to" the above-identified patent and U.S. Patent No. 5,595,997 (collectively "Patents"). Although the entire right, title, and interest in and to Patents

were originally assigned to Sepracor, Sepracor subsequently assigned one half of its entire right, title, and interest in and to the Patents to University of Massachusetts, Worcester, MA. The second assignment was recorded at the Patent Office at Reel 008754, Frame 0866, a copy of which is attached hereto as **Exhibit A**. Even though the March 17, 2006 terminal disclaimer was reviewed and approved by the Patent Office, a corrected terminal disclaimer which complies with 37 C.F.R. §§ 1.321 and 3.73, and which is executed by both Sepracor and University of Massachusetts, is submitted herewith.

Based on the foregoing, Patentees wish to correct the record to reflect that the Patents are jointly owned by Sepracor and University of Massachusetts. Consequently, it is respectfully requested that the March 17, 2006 terminal disclaimer be replaced with the terminal disclaimer submitted herewith. It is further requested that the terminal disclaimer executed by both assignees be placed in the above-identified file.

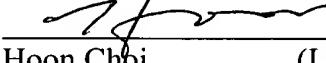
Conclusion

For the foregoing reasons, it is respectfully requested that the terminal disclaimer executed by both assignees be accepted, and that this terminal disclaimer be entered into the record of the above-identified patent file-wrapper.

A fee of \$ 400.00 is believed due for this submission. Please charge this and any other required fees to Jones Day Deposit Account No. 503013.

Respectfully submitted,

Date May 30, 2007


Hoon Choi L0209
(Ltd. Recog. No.)
JONES DAY

For: Anthony M. Insogna (Reg. No. 35,203)
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COPY

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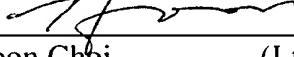
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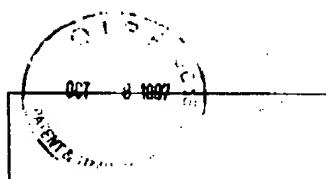
Respectfully submitted,

Date May 30, 2007


Hoon Choi L0209
JONES DAY (Ltd. Recog. No.)

For: Anthony M. Insogna (Reg. No. 35,203)
JONES DAY
12265 El Camino Real, Suite 200
San Diego, CA 92130
(858) 314-1200

Exhibit A



10-27-1997

EXPRESS MAIL NO. T86866268534

ET

Attorney Docket Number
4821-206

100557585

TO THE HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS
Box Assignment
Washington, DC 20231

MSA 10-8-97

Please record the attached original documents or copy thereof.

1. Name of conveying parties: Sepracor, Inc.	2. Name and address of receiving party: Name University of Massachusetts Address 18 Tremont Street Boston, Massachusetts 02108
Additional name(s) of conveying party(ies) attached? <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No	
3. Nature of conveyance: <input checked="" type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input type="checkbox"/> Other _____	
Execution Date: September 12, 1997	Country (if other than USA): _____

4. Application number(s) or patent number(s). If this document is being filed together with a new application, the execution date of the application is: _____	
A. Patent Application No. 08/366,651, filed December 10, 1994	B. Patent No.(s) 5,595,997
Additional numbers attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	

5. Name and address of party to whom correspondence concerning document should be mailed: PENNIE & EDMONDS LLP 1155 Avenue of the Americas New York, NY 10036	6. Number of applications and patents involved: 1
	7. Total fee (17 CFR 3.41) \$ 40.00 Please charge to the deposit account listed in Section 8
	8. Deposit account number: 16-1150

DO NOT USE THIS SPACE

9. Statement and signature <i>To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.</i>			
Stephen T. Lawrence, III Name of Person Signing	45-736 Reg. No.	Stephen T. Lawrence, III Signature	October 8, 1997 Date
Total number of pages including cover sheet 3			

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignment
Washington, D.C. 20231

10/23/1997 JSH08022 00000027 DAW:161150 08366651
Sale Ref: 00000028 DAW: 161150 08366651
01 FC:5A1 40.00 CH

PATENT
RTE 1, 8754 FRAMES 0866 PER 10000001

ASSIGNMENT

WHEREAS, the inventors, A.K. Gunnar Aberg, John R. McCullough and Emil R. Smith, citizens of Sweden, the United States and the United States, respectively, by an Assignment executed March 1, 1995, which was recorded in the United States Patent and Trademark Office on March 6, 1995, at Reel No. 7432, Frame No. 712, have assigned their full and exclusive right in and to the invention set forth in U.S. Application Serial No. 08/366,651, filed December 30, 1994 entitled **METHODS AND COMPOSITIONS FOR TREATING ALLERGIC RHINITIS AND OTHER DISORDERS USING DESCARBOETHOXYLORATADINE** to Sepracor Inc., having a principle place of business at 111 Locke Drive, Marlborough, Massachusetts 01752, a Delaware corporation ("Assignor"); and

WHEREAS, Assignor has taken the entire right, title and interest in the above-mentioned patent application; and

WHEREAS, University of Massachusetts, 18 Tremont Street, Boston, Massachusetts 02108 ("Assignee") desires to acquire an undivided one-half (1/2) interest in said invention; and WHEREAS, Assignor is willing to assign such an interest therein to Assignee while Assignor retains an undivided one-half (1/2) interest.

NOW, THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, Assignor does hereby assign, sell, and transfer to Assignee, its successors, assigns and legal representatives, an undivided one-half (1/2) interest in said invention and patent application, and any continuation, continuation-in-part, division, substitute, reissue, or extension thereof and any patents issuing thereon properly naming Emil R. Smith as an inventor.

This assignment is subject to an exclusive license agreement between the Assignor and the Assignee dated 12 September, 1997.

Assignor further covenants with said Assignee, its successors, assigns and legal representatives that no Assignment, grant, mortgage, license or other agreement affecting the rights and property hereinafter conveyed has been made to others by the undersigned, and that the full right to convey the same as herein expressed is possessed by the undersigned.

In testimony whereof, Timothy J. Barberich as authorized representative of Sepracor Inc. has hereunto set his signature this 12th day of Sept., 1997.

SEPRACOR INC.
111 Locke Drive
Marlborough, Massachusetts 01752

By: Timothy J. Barberich
Timothy J. Barberich
President

State of Massachusetts)
) SS.:
County of Middlesex)

On this 12th day of September, 1997, before me, a Notary Public in and for the State and County aforesaid, personally appeared Timothy J. Barberich, to me known and known to me to be the person of that name, who signed and sealed the foregoing instrument, and he acknowledged the same to be his free act and deed.

Julie D. Parker
Notary Public

JULIE D. PARKER
Notary Public
My Commission Expires May 14, 2004